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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/539,872	12/21/2005	Nancy Hathaway	21309YP	6359

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EXAMINER	
KAROL, JODY LYNN	

ART UNIT	PAPER NUMBER
1617	

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03/12/2009	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No.	Applicant(s)	
	10/539,872	HATHAWAY ET AL.	
	Examiner	Art Unit	
	Jody L. Karol	1617	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE *3* MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *18 July 2008*.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1,2,7-18,20 and 21* is/are pending in the application.

4a) Of the above claim(s) *9* is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-2, 7-8,10-18, and 20-21* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date *9/15/2008 and 9/25/2008*.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

DETAILED ACTION

Receipt is acknowledged of applicant's Amendment/Remarks filed 7/18/2008. Claims 20-21 have been amended. Claims 4-6 and 19 have been cancelled. Claim 4 was previously cancelled. Claim 9 remains withdrawn as directed to the non-elected invention. Thus, claims 1-2 and 7-are currently under consideration/pending.

Information Disclosure Statement

1. The information disclosure statements (IDS) filed on 9/15/2008 and 9/25/2008 are in compliance with the provisions of 37 CFR 1.97. Accordingly, the information disclosure statements have been considered.

WITHDRAWN REJECTIONS

2. In view of Applicant's amendment to the trademarks in the specification, the objection to the specification is herein withdrawn.

3. In view of Applicant's response and cancellation of claim 19, the rejection of claims 1-2, 7-8, and 10-21 under 35 U.S.C. 112, first paragraph, for lack of enablement for prevention of Parkinson's disease is herein withdrawn. Specifically, Applicant states the remaining claims are not drawn to prevention of Parkinson's disease, and thus treatment is not equated with prevention for said claims.

4. In view of Applicant's amendment to claims 20-21, the rejection of claims 1-2, 7-8, and 10-21 under 35 U.S.C. 112, as being indefinite for containing the tradmark/tradename Vioxx® is herein withdrawn.

Response to Arguments

5. Applicant's arguments filed 7/18/2008 have been fully considered but they are not persuasive.

Applicant alleges that the withdrawal of claim 9 is in error. The Examiner respectfully disagrees. The elected species of a first antiparkinson agent is pergolide while claim 9 is directed to methods where the first antiparkinson agent is segiline. Segiline is the species elected as the second antiparkinson agent in claim 10. Thus, segiline is only considered when it is administered as a second antiparkinson agent, and pergolide is a first antiparkinson agent.

Applicant alleges that Example 1 on page 15 of the instant specification demonstrate the dramatic and surprisingly superiority of the invention. It appears Applicant is alleging that the administration of pergolide, selegiline, and rofecoxib in a patient with Parkinson's disease exhibit unexpected synergism. In response, it is respectfully submitted that it is applicant's burden to demonstrate unexpected results over the prior art. See MPEP 716.02, also 716.02 (a) - (g). Furthermore, the unexpected results should be demonstrated with evidence that the differences in results are in fact unexpected and unobvious and of both statistical and practical significance. *Ex parte Gelles*, 22 USPQ2d 1318, 1319 (Bd. Pat. App. & Inter. 1992). Moreover,

evidence as to any unexpected benefits must be "clear and convincing" *In re Lohr*, 137 USPQ 548 (CCPA 1963), and be of a scope reasonably commensurate with the scope of the subject matter claimed, *In re Linder*, 173 USPQ 356 (CCPA 1972).

In the instant case, the evidence presented is not clear and convincing or of statistical and practical significance because the Applicant only presents one example with no comparison. Typically the evidence submitted to establish unexpected synergism should compare each of the ingredients by themselves with the combination as claimed in the method in which the three ingredients are administered together. Further, in order for the tests to be truly comparative, the amounts of each of the individual active ingredients should be the same as the total amount of the ingredients administered together in the claimed method. In this case, pergolide and selegiline are administered together for 6 months before rofecoxib is added to the treatment regime. There is no data showing the individual ingredients administered alone, or in amounts the same as the total amount of the active agents combined. Thus, a comparison cannot be made, and it is not clear whether the results are actually unexpected or of any significance.

Therefore, no clear and convincing unexpected benefit is seen to be present herein. Thus, the instant claims are still considered properly rejected under 35 USC 103(a).

Thus, for these reasons, Applicant's arguments are found unpersuasive. Said rejections are maintained and reproduced below for Applicant's convenience.

MAINTAINED REJECTIONS

6. The following rejections have been maintained from the previous Office Action dated 4/16/2008:

Claim Rejections - 35 USC § 103

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

The factual inquiries set forth in *Graham* **v.** *John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

8. Claim 18 is rejected under 35 U.S.C. 103(a) as being unpatentable over Block et al. (WO 00/27382).

The instant claim 18 is directed to methods of slowing the progress of Parkinson's disease and preventing Parkinson's disease comprising administration to a patient in need thereof a therapeutically effective amount of the selective COX-2 inhibitor VIOXX® (rofecoxib).

Block et al. teaches the administration of a therapeutically effective amount of a combination of $GABA_A$ alpha 5 inverse agonist and COX-2 inhibitor for treating neurodegenerative conditions such as Parkinson's disease (see abstract, page 1, lines 27-30, and page 22, lines 10-16). Block et al. further teaches that the COX-2 inhibitor is preferably rofecoxib (VIOXX®) (see page 33, lines 17-18).

Block et al. does not explicitly teach a method of treating Parkinson's disease comprising the administration to a patient in need thereof a therapeutically effective rofecoxib.

However, it would have been obvious to one of ordinary skill in the art at the time of the invention, to treat Parkinson's disease in a patient comprising the administration to said patient a therapeutically effective rofecoxib using the guidance of Block et al. One of ordinary skill in the art would have a reasonable expectation of success in doing so because the prior art as a whole teaches treating Parkinson's disease with rofecoxib.

Thus, the invention would have been *prima facie* obvious to one skilled in the art at the time it was made.

9. Claims 1-2, 7-8, 10-17, and 20-21 are rejected under 35 U.S.C. 103(a) as being unpatentable over Block et al. (WO 00/27382) as applied to claim 18 in view of Shapiro (US 5,668,117).

Claims 1-2, 7-8, 10-17, and 20-21 are directed to methods of treating Parkinson's disease, relieving the symptoms of Parkinson's disease and/or ameliorating/slowing the progress of Parkinson's disease comprising administration of a therapeutically effective amount of pergolide, and rofecoxib, and in claims 10 and 21, additionally selegiline.

Block et al. is described *supra* as applied to claims 16-18.

Shapiro teaches known antiparkinson agents used in the treatment of Parkinson's disease, such as pergolide mesylate and selegiline (see columns 28-30, lines 30-25) in combination with a carbonyl trapping agent in the clinical treatment of Parkinson's disease (see abstract).

Shapiro et al. does not teach COX-2 inhibitors such as VIOXX® (rofecoxib) in the treatment of Parkinson's disease.

However, it would have been obvious to one of ordinary skill in the art to treat Parkinson's disease by administering therapeutically effective amounts of (1) rofecoxib as taught by Block et al. in combination with (2) pergolide and/or (3) selegiline as taught by Shapiro. One of ordinary skill in the art would have been motivated to combine these components to treat Parkinson's disease because they are individually taught in the art to treat Parkinson's disease. It is obvious to combine individual compositions taught to

have the same utility to form a new composition for the very same purpose (See *In re Kerkhoven*, 626 F.2d 846, 205, U.S.P.Q. 1069 (C.C.P.A. 1980)).

In regards to the instant claim 13, where the combination of pergolide and rofecoxib is claimed to provide greater relief than pergolide alone, it is expected that these two agents would have an additive effect because they are both known to be used in the treatment of Parkinson's disease.

In regards to the instant claims 11 and 17, that claim methods of treating the different stages/types of Parkinson's disease, it is presumed that the above components (rofecoxib, pergolide, and selegiline) taught by the prior art, treat all stages and types of Parkison's disease absence evidence to the contrary.

Thus, the invention would have been *prima facie* obvious to one skilled in the art at the time it was made.

Conclusion

No claims are allowed.

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the

shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Correspondence

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jody L. Karol whose telephone number is (571)270-3283. The examiner can normally be reached on 8:30 am - 5:00 pm Mon-Fri EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Sreeni Padmanabhan can be reached on (571) 272-0629. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

/JENNIFER M KIM/
Primary Examiner, Art Unit 1617

/Jody L. Karol/

Examiner, Art Unit 1617